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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,107	01/12/2001	Elliott D. Light	2344-001-CIP2	1835

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EXAMINER

WEAVER, SCOTT LOUIS

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,107

Applicant(s)

LIGHT ET AL.

Examiner

Scott L. Weaver

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 September 2004 and 28 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-29, 49 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 49 and 51 is/are allowed.
- 6) ☒ Claim(s) 17-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment and Arguments

1. Applicant's arguments filed 9/8/2004 and 10/28/2004 have been fully considered but they are not persuasive. The remarks of the response which refer to the support for claims 17-29 being provided via Patent #6,483,900 raises new issues of proper enabling disclosure, and as such any new rejections are provided in response to applicants remarks related thereto

According to the response of 9/8/2004 , the previous reference (Huna et al.) is not prior art because the invention claimed via claims 17-29 was presented in the specification of 6,483,900. The examiner can not agree with this however.

Upon review of 6,483,900, it is clear that "email" was disclosed as being sent via a PC to another PC therein , however, the 6,483,900 Patent makes no reference to the phrase "alphanumeric messages" which was first introduced in the disclosure (claims) of the instant application and which does include more than "email"; pagers for instance receive alphanumeric messages and SMS (Short Message Service) enables alphanumeric messages to be sent and received via wireless PC, PDA and other mobile devices. While it is anticipated the applicant will suggest email can be alphanumeric, this does not mean alphanumeric is only email. As such the instant claims broadened the scope of the disclosure relied on in the remarks to suggest earlier support to the claimed invention and as such do not have earlier support.

Further, the 6,483,900 Patent does not refer to wireless PCs (PC was the only email message creation device recited therein) nor of telephones (wireless or otherwise) sending or 'enabling a user to ' create alphanumeric messages or "email". Reference to the creation device being other than a PC and wireless was first disclosed on page 6 paragraph numbered 25 of the instant application

As such, the Huna reference is considered adequate to teach the limitations as presented in the claims as alphanumeric was first introduced via the filing of the instant application which is after the filing of the Huna 6,438,217 reference and wherein Huna clearly teaches the alphanumeric message sending as claimed and pointed out below in Paragraph 4.

Further references applicable to the claims are noted in the pertinent prior art section below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 17-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention..

In claim 17, on (ln.6) reference is made to “ message creation device ‘creates’ an alphanumeric message” which is inaccurate of the disclosed invention . There is no disclosure of a device which creates a message, consider a computer has capability of enabling a user to create a message using the computer, but the message is not created by the computer alone. Applicant fails to provide a device which creates a message. A device which creates a message could not be manufactured or made form the disclosure attempting to support such device as claimed.

This same rejection was previously provided with suggestion that such was inaccurate, and the remarks merely indicate they agree, this does not change the scope of the claim.

A mere rewording of ‘creates’ to ‘enables a user to create’ will avoid the citing of the above 35 U.S.C. 112 rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 17-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Huna (#6,438,217).

The claims read on Huna as follows: Huna teaches (col.14,ln.38-col.15,ln.38) as pertains to claim 17, system for communicating over network which includes voice mail converter (message server 402) which converts alphanumeric (textual) message to voice mail message and enables called party to access (receive) the voice mail message which has been sent from an originating terminal (message creation device), which enables a sender to create the message thereat for sending over the network for conversion into voice mail by the voice mail converter (col.17,ln.1-11; col.17,ln.50-53) . With respect to claim 18, the network is a wireless network (figure 5) teaches use of pager and (col.1,ln.45-49) teaches the telephony-centric network includes a network that carries telephony information such as voice...page messages...to facilitate information exchange among telephony devices and (col.1,ln.53-58) teaches telecommunications device includes POTS telephone, cellular telephone, PDA, video telephone, thus any telephone which can dial a telephone number and connect to the defined telephony-centric network of the invention including wireless is taught by Huna and as applies to claims 18-29.

Conclusion

6. Claims 49 and 51 are allowed over the prior art of record 'at this time'.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Frohman et al (#5,418,835) teaches transmitting text message entered via various devices to a voice mail storage for retrieval by recipient (Abstract; col.2,ln.25-39; col.3,ln.3-40; col.4,ln.11-49)

"They're Here: Portable E-Mail and Voice Mail", PC WEEK Page 55 February 12, 1990 refers to a firm called "VoxLink" which enables phone user to hear E-mail message.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

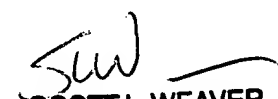
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2645

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Weaver whose telephone number is 703-308-6974. The examiner can normally be reached on Tuesday to Friday 8 AM to 6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SCOTT L. WEAVER
PRIMARY EXAMINER
Art Unit 2645